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EXAMINER

STEVENS, THOMAS H

ART UNIT

PAPER NUMBER

2123

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Please find below and/or attached an Office communication concerning this application or proceeding.

3

## Office Action Summary

Application No.

09/649,193

Applicant(s)

SINGH, RAMINDERPAL

Examiner

Thomas H. Stevens

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2000 and 13 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/28/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/31/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Trademarks*

1. Claim 4 contains the trademark/trade name UNIX. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

### *Specification Objection*

2. The disclosure is objected to because of the following informalities: The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (pg.1, line 15: <http://www.nasa.gov>). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 8 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, specifically, the term, "proprietary format", for which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C 112, second paragraph based on claim 1 reciting the limitation "network" in line 9. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 1 is rejected under 35 U.S.C 112, second paragraph based on the term "open system", which renders the claim indefinite. The term "open system" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

8. Claims 8 and 18 are rejected under 35 U.S.C. 112, second paragraph based on the term "proprietary format". The term "proprietary format" is not defined by the claim, the specification does not provide a standard for

ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

9. Claims 13, 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase, "for storing further" is vague and indefinite.

10. Furthermore, claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase, "accepting a connection" is vague and indefinite.

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 12-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a computer program product, which is non-statutory matter. The examiner respectfully submits that the applicants have not claimed a practical application. An invention which is eligible for patenting under 35 U.S.C. § 101 is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result.

The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors: The examiner respectfully submits, under current PTO practice, that the claimed invention does not recite a tangible or concrete result. The claims are not tangible because they appear to recite a computer program product used to model and analyze local area networks in a confined or limited space that doesn’t have specific preprocessing or post solution activity.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1,9,12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dalpasso et al. (Paper: “Virtual Simulation of Distributed IP-based Designs”. (1999)). Dalpasso et al. teaches virtual simulation of distributed IP-based designs that encompasses designs creations and changes to third parties via the Internet (pg. 51, left column second paragraph), through a secure network (pg. 52, section 3.3, left column, third bullet).

**Claim 1:** A method for facilitating an open simulation between a first simulation engine (pg. 51, left column, second paragraph) and at least a second simulation engine, wherein said first and second simulation engines are communicatively coupled together with a simulation portal over a computer network (pg. 51, left column, first paragraph), said method comprising the steps of: creating said simulation portal openly accessible to said first and second simulation engines connected to said network; accepting a connection to said simulation portal by each of said first simulation engine and said second simulation engine; receiving a simulation output file from said first simulation engine; storing said simulation output file as part of a simulation in a data storage area associated with said simulation portal; and providing said simulation output file upon request to said second simulation engine.

**Claim 9:** A system for performing simulations wherein a first simulation engine and at least a second simulation engine are communicatively -coupled together with a simulation portal over a computer network (pg. 51, left column, first paragraph), said system comprising: means for creating said simulation portal; means for accepting connections to said simulation portal from each of said first simulation engine and said second simulation engine; means for receiving a simulation output files from said first simulation engine; means for storing said simulation output file as part of a simulation in a data storage area associated

with said simulation portal; and means for providing said simulation output file upon request to said second simulation engine.

**Claim 12:** A computer program product for facilitating an open simulation between a first simulation engine and at least a second simulation engine (figure 1), wherein said first and said second simulation engines are communicatively coupled with a simulation portal over a computer network, said computer program product comprising (pg. 51, left column, first paragraph): instructions for making said simulation portal openly accessible to said simulation engines over said computer network; instructions for accepting a connection to said simulation portal from each of said first simulation engine and said second simulation engine; instructions for receiving a simulation output file uploaded from said first simulation engine; instructions for storing said simulation output file uploaded from said first simulation engine as part of a simulation in a data storage area associated with said simulation portal; and instructions for providing said simulation output file to said second simulation engine upon request.

**Claim 19:** A method for optimizing the components in a system design comprising the steps of: creating a simulation portal that is openly accessible over a computer network; publishing a system design specification model; accepting a connection to said simulation portal from each of a plurality of design teams communicatively coupled together with said simulation portal over said computer network (pg. 51, left column, first paragraph); receiving a simulation output file from at least one of said design teams connected to said simulation



portal; storing said simulation output files as part of a simulation in a data storage area associated with said simulation portal; providing at least one of said simulation output files to at least one of said design teams connected to said simulation portal; and selecting the optimal components for said system design based on a comparison of said simulation output files (pg. 53, right column, section 4.2).

***Claim Rejections - 35 USC § 103***

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 2-8,10,11,13-18, and 20 are rejected under 35 U.S.C. 103(b) as anticipated by Dalpasso et al. (Paper: "Virtual Simulation of Distributed IP-based Designs". (1999)) in view of Donoho et al. (U.S. Patent 6256,664 (1998)).

Dalpasso et al. teaches virtual simulation of distributed IP-based designs that encompasses designs creations and changes to third parties via the Internet (pg. 51, left column second paragraph), through a secure network (pg. 52, section 3.3, left column, third bullet). However, it doesn't teach this process by way of Unix and XML software, with it applicable security features.

Donoho et al. teaches a collection of computers and associated communications infrastructure to offer a new communications process, by secure means (abstract), which encompass simulation (column 44, lines 1-27) Unix and XLM software (column 80, lines 30-34; and column 85, lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the teachings of Dalpasso et al. in view of Donoho et al. since it would have been advantageous for a client to have secure access to avoid interruptions of the simulation by way of proprietary protocols (XML).

**Claim 2:** The method of claim 1 wherein said creating said simulation (Donoho: figure 17, (172)) portal step further comprises the steps of: creating said simulation portal using XML (Donoho: column 85, lines 4-9); and configuring said simulation portal to allow connections from each of said simulation engines connected to said network (Dalpasso: pg. 50, figure 1).

**Claim 3:** The method of claim 1(Dalpasso: pg. 51, left column, second paragraph) whereby said data storage area is a database (Donoho: figure 18).

**Claim 4:** The method of claim 1(Dalpasso: pg. 51, left column, second paragraph) whereby said data storage area is a UNIX mailbox file (Donoho: column 86, lines 43-67).

**Claim 5:** The method of claim 1(Dalpasso: pg. 51, left column, second paragraph) whereby said data storage area (Donoho: figure 18) is a hierarchical file system (Dalpasso: pg. 51, right column, first paragraph).

**Claim 6:** The method of claim 1(Dalpasso: pg. 51, left column, second paragraph) whereby said data storage (Donoho: figure 18) area manages simulation output files for multiple simulations running (Dalpasso: pg. 51, left column, first paragraph) contemporaneously.

**Claim 7:** The method of claim 1(Dalpasso: pg. 51, left column, second paragraph) wherein said accepting a connection step further comprises: verifying said connection with a username and password combination (Donoho: column 37, lines 45-55).

**Claim 8:** The method of claim 1 (Dalpasso: pg. 51, left column, second paragraph) whereby communications between said simulation engines and said simulation portal uses a proprietary format (Donoho: column 85, lines 4-9).

**Claim 10:** The system of claim 9 (Dalpasso: pg. 51, left column, second paragraph) whereby said means for creating said simulation portal include creating said simulation portal in XML (Donoho: column 85, lines 4-9).

**Claim 11:** The system of claim 9 (Dalpasso: pg. 51, left column, second paragraph) whereby said means for accepting connections includes verifying said connection with a username and password combination (Donoho: column 37, lines 45-55).

**Claim 13:** The computer program product of claim 12 (Dalpasso: pg. 51, left column, second paragraph) wherein said instructions for storing further comprise instructions for storing said simulation output file in a database (Donaho: column 6, lines 19-24).

**Claim 14:** The computer program product of claim 12 (Dalpasso: pg. 51, left column, second paragraph) wherein said instructions for storing further comprise instructions for storing said simulation output file in a UNIX mailbox file (Donoho: column 86, lines 43-67).

**Claim 15:** The computer program product of claim 12 (Dalpasso: pg. 51, left column, second paragraph) wherein said instructions (Donoho: column 6) for storing further comprise instructions for storing said simulation output file in a hierarchical file system (Dalpasso: pg.51, right column, first paragraph).

**Claim 16:** The computer program product of claim 12 wherein said instructions for storing further comprise instructions (Donoho: column 44, lines 1-4) for managing simulation output files for multiple simulations running (Dalpasso: pg. 51, left column, first paragraph) contemporaneously.

**Claim 17:** The computer program product of claim 12 (Dalpasso: pg. 51, left column, second paragraph) wherein said instructions for accepting a connection further comprise instructions for verifying said connection with a username and password combination (Donoho: column 37, lines 45-55).

**Claim 18:** The computer program product of claim 12 (Dalpasso: pg. 51, left column, second paragraph) further comprising instructions for communicating with said simulation portal in a proprietary format (Donoho: column 85, lines 4-9).

**Claim 20:** The method of claim 19 (Dalpasso: pg. 51, left column, second paragraph) wherein said accepting a connection step further comprises verifying

said connection with a username and password combination (Donoho: column 37, lines 45-55).

***Correspondence Information***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Stevens whose telephone number is (703) 305-0365, Monday-Friday (8:30 am- 5:30 pm) or contact Supervisor Mr. Kevin Teska at (703) 305-9704. The fax number for the group is 703-872-9306.

Any inquires of general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (703) 305-3900.

March 5, 2004

THS